

REMARKS

The Office Action dated March 9, 2006, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 1, 10 and 12 have been amended. No new matter has been added. Claims 1-7 and 10-20 are pending and respectfully submitted for consideration.

Entry of Response Proper

Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues requiring further search and/or consideration on the part of the Examiner as the Amendment merely clarifies the direction the projection of each ball holder extends; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to objections raised in the Final Rejection. Entry of the Amendment is thus respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 10-12, 17 and 20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kong (U.S. Patent No. 6,576,329 B2). The Applicants traverse the

rejection and respectfully submit that claims 1-4, 10-12, 17 and 20 recite subject matter that is neither disclosed nor suggested by Kong.

The claimed invention is directed to a security document card that can form, for example, a regularly accessed page of the passport because the material and structure of the security document card of the present invention prevents the page from breaking and detaching from the passport. Therefore, the page containing the security document card can be repeatedly bent, for example, when the passport is opened and closed at various border control stations. The Applicants respectfully submit that the issue of bending is not addressed in Kong. The packaging material or decorative wrap material in Kong is only wrapped around the product once. Specifically, the packaging material in Kong is bent only once and then unwrapped and thrown away. The Applicants further submit that Kong fails to disclose or suggest additional features of the invention, and therefore, fails to provide the critical and non-obvious advantages provided by the invention, as discussed below.

The stability and rigidity of the security document card of the present invention allows the card to be turned over easily by hand. Accordingly, the security document card of the present invention has a thickness of at least 120 μm for the support and at least 100 μm for the layer thickness so that the total thickness amounts to at least 220 μm (8.7 mils) See page 3, lines 10-16 of the specification.

Further, the cards of the present invention provide temperature stability and environmental compatibility and can be printed upon or written into or engraved with information. Accordingly, as a result of the claimed invention, personalized or customized information is incorporated into the security document card by a laser. The

personalized or customized information allows the security document card to be related to the document holder. The laser-engraved information produces an embossment that functions to secure the information at the surface of the coating of the security document card. Similarly, the laser-written information is written underneath the surface within the coating layer by the laser. There, the laser causes a chemical reaction, burning components of the coating layer and producing small black or colored particles and/or gas bubbles which can be seen from outside. These particles and gas bubbles form the (personalized or customized) information. Thus, the structure of the coating is changed to impart the laser-written information therein. If the energy of the laser exceeds a certain amount and/or the material of the coating is chosen appropriately for laser-engraving, the surface profile of the coating is also changed.

With respect to amended claim 1, the Applicants respectfully submit that Kong fails to disclose or suggest the claimed features of the invention. Amended claim 1 recites a support of a security document card. In contrast, Kong discloses a multilayer thermoplastic film. The thermoplastic film is not comparable to the security document card of the present invention at least because there is no security feature and there is no card. Therefore, as Kong fails to disclose or suggest each and every feature of the invention as recited in claim 1, the reference does not provide the critical and non-obvious advantages of the present invention as discussed above.

With respect to amended claim 12, the Applicants respectfully submit that Kong fails to disclose or suggest the claimed features of the invention. Amended claim 12 recites that the coating containing polycarbonate is fastened to the support of the security document card by means of a hot-melt adhesive. As discussed above, Kong

fails to disclose or suggest a security document card. The previous Office Action dated October 7, 2005, took the position that Kong teaches, "that the laminate may be formed using hot melt adhesives (col. 6, lines 9-27, for instance)". See page 3, lines 14-15 of the October 7, 2005, Office Action. However, the Applicants respectfully submit that there is no disclosure or suggestion that the heat sealability of the first and second skin layers in Kong involves a hot-melt adhesive as recited in claim 12.

Further, column 6, lines 9-27, does not disclose hot-melt adhesives. In contrast, this section of Kong discloses heat sealable blends. Heat sealable blends are not comparable to hot-melt adhesives. As set forth in the attached publication entitled "On Hot-Melt, Heat-Seal and Hot-Set Adhesives" by Gustav A. Berger, for the Examiner's reference, a heat seal is different from a hot-melt adhesive. Thus, the application of a heat seal is different from the application of a hot-melt adhesive. Therefore, the Applicants respectfully submit that the Kong reference fails to disclose at least the feature of a hot-melt adhesive that fastens a coating containing a polycarbonate to a support containing a high-density polyethylene and a linear low-density polyethylene, as recited in claim 12.

With respect to claim 10, which depends from claim 1, the Applicants respectfully submit that Kong fails to disclose or suggest the claimed features of the invention. Claim 10 recites a security document card according to claim 1, wherein the coating comprises laser-engraved or laser-written information. The Office Action took the position that the engraving or writing feature of claim 10 is not distinguishable over Kong, and further took the position that writing is not functionally related to the product. See page 3, paragraph 6 of the Office Action. Although MPEP § 2112.01 states that

"[w]here the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art," under U.S. patent practice, printed matter will be considered patentable subject matter if it bears a functional relationship to the invention's structural elements. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. See In re Gulack, 703 F. 2d 13811385-1386. In this case, the Applicants respectfully submit that there is a new and unobvious functional relationship between the laser-engraved and laser-written information recited in claim 10, as discussed above, and below.

Claim 10 recites the structural feature of laser engraving or laser writing, which are functionally related to the security document card. In this case, the laser engraving produces a raised embossment which functions to physically secure the surfaces of the security document card. Therefore, the data is more secure and it is not easily changed or deleted. Laser-writing, as discussed above, causes a chemical reaction in the coating layer and produces visible small black or colored particles and/or gas bubbles that form the personalized or customized information of the security document card. Specifically, the structure of the coating is changed to impart the laser-written information therein. The Applicants respectfully submit that laser engraving and laser writing result in a product that is different from the product of Kong, which does not have laser engraving or laser writing. As Kong does not disclose or suggest at least the feature of laser-engraved or laser-written information, the reference fails to disclose or suggest the features of the invention as recited in claim 10.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . . [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Kong does not disclose or suggest a security document card as recited in claim 1, a coating containing polycarbonate being fastened to the support by means of a hot-melt adhesive, as recited in claim 12, or a coating that comprises laser-engraved or laser-written information, as recited in claim 10. Accordingly, Kong does not anticipate claims 1, 10 and 12, nor are claims 1, 10 and 12, obvious in view of Kong. As such, the Applicants submit that claims 1, 10 and 12 are allowable over Kong.

Further, with respect to claims 2-4, 11 and 17 the Applicants respectfully submit that Kong also fails to disclose or suggest the claimed features of the invention. Claims 2-4, 11 and 17 depend from claim 1. As discussed above, Kong fails to disclose the features of the invention recited in claim 1. As such, Kong fails to disclose or suggest the features of the invention as recited in claim 1, and, therefore, dependent claims 2-4, 11 and 17.

Rejections Under 35 U.S.C. § 103

Claims 5-7, 13-16, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kong. The Applicants traverse the rejection and respectfully submit that claims 5-7, 13-16, 18 and 19 are allowable based upon their dependency from allowable claims 1 and 12.

In addition, with respect to claim 19, the Applicants respectfully submit that major differences exist between a film for packaging and a security document card. Claim 19 recites the layer thickness of the support being at least 120 μm and the layer thickness of the coating being at least 100 μm . The Office Action dated October 7, 2005, took the position that Kong discloses a range of thicknesses for the various layers and selecting optimum or workable ranges is not considered to be inventive. See page 4 lines 4-6 of the October 7, 2005, Office Action. However, under U.S. patent practice, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). See MPEP 2144.05 III. In contrast to claim 19, Kong discloses that the thickness of the film is merely 20 microns and that each of the first skin layer and second skin layer is "less than about 2 microns". See column 6, lines 28-33 of Kong. As such, Kong teaches away from a layer thickness of the support of at least 120 μm and a layer thickness of a coating of at least 100 μm .

In the response to Applicants' arguments, the Office Action took the position that column 6, lines 28-33 of Kong is directed to a preferred embodiment and in no way teaches away from the other thicknesses. The Office Action further stated that this preferred embodiment in Kong is not limiting on the disclosure of Kong. See page 3,

paragraph 8 of the Office Action. The Applicants respectfully submit, however, that even though Kong refers to the thickness in a particular embodiment, there is no alternative teaching in Kong to disclose a different thickness. The entire disclosure of Kong, teaches away from the claimed layer thickness of the support and layer thickness of the coating. Furthermore, the Applicants provide an explanation regarding the criticality of the thickness of the support, as discussed above and in the Specification of the present application. Additionally, what would be an optimum or workable range for thickness of a film to be used for heat sealable packaging is not applicable to a security document card as disclosed and claimed. The Applicants respectfully submit that there is no other thickness in Kong that teaches the claimed features of the invention as recited in claim 19. Specifically, all of the embodiments in Kong, including the passage on page 6, lines 28-33, teach away from a layer thickness of the support being at least 120 μm and the layer thickness of the coating being at least 100 μm . The Examiner has provided no motivation to change the thickness taught in Kong. Therefore, Kong does not disclose or suggest the claimed invention and cannot provide the critical and non-obvious advantages of the present invention discussed above.

In view of the above, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 5-7, 13-16, 18 and 19 under 35 U.S.C. §103.

Conclusion


Claims 2-7, 10, 11, 19 and 20 depend from claim 1 and claims 13-16 depend from claim 12. The Applicants respectfully submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same

reasons as discussed above. Accordingly, the Applicants respectfully request withdrawal of the rejections, allowance of claims 1-7 and 10-20 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 028605-00003.**

Respectfully submitted,


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Enclosure: Article: "On Hot-Melt, Heat-Seal and Hot-Set Adhesives"